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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,333	04/18/2006	Vaughn W. North	20660.PROV.PCT.US	7733

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EXAMINER
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LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/541,333

Applicant(s)

NORTH ET AL.

Examiner

F. Daniel Lopez

Art Unit

3745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2-9, 11-13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 10, 14, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/6/05</u> | 6) <input type="checkbox"/> Other: ____  |

***Lack of Unity***

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. The species are as follows:

- species I is shown in Fig. 1, having an impeller;
- species II is shown in Fig. 1, having covers positioned over opposing ends of the tubes;
- species III is shown in Fig. 5, having a linearly moving plate;
- species IV is shown in Fig. 8, having a rotary moving plate;
- species V is shown in Fig. 10, 11, 13, and 14, having an anemometer; and
- species VI is shown in Fig. 15a-15d, having a drag body attached to a rotatable platform.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

- Claims 2 and 3 correspond to species I;
- Claims 5 and 6 correspond to species III;
- Claim 7 corresponds to species IV;
- Claim 13 corresponds to species II;
- Claims 10 and 15 correspond to species V; and
- Claim 16 correspond to species VI.

The following claim(s) are generic: claims 1, 14 and 17 are generic to all species; claim 4 is generic to species III and IV; and claims 11 and 12 are generic to species I and II.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

the common technical features of claims 1, 7, 14, and 17, are disclosed by either Hill (US 4,748,808) or Pitts (4,850,190). Hill discloses an energy transducer device comprising a mounting base (17) positioned on the ocean floor; and an electro-mechanical transducer positioned within the flow path and responsive to reciprocating water movement along the flow path, to generate electrical current (by 19); wherein the electro-mechanical transducer includes a plate (10) rotatable about an axis.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

During a telephone conversation with Vaughn North on January 17, 2007, a provisional election was made without traverse to prosecute the invention of species v, claims 1, 10, 14, 15 and 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-9, 11-13 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Double Patenting***

Applicant is advised that should claim 1 be found allowable, claims 14 and 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It is understood that claim 1 claims that the transducer is "for positioning at the ocean floor for converting wave action at an ocean surface", with "a flow path in a substantially horizontal orientation"; claim 14 claims that the transducer is "for positioning at the ocean floor for converting water movement along a shoreline"; and claim 17 claims that the transducer is "for positioning at the ocean floor for converting wave action at an ocean surface". These differences are all claimed as intended use (e.g. configured for of claim 1 line ), and therefore are not given patentable weight.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 10, 14, 15 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by either Hung, Hill or Pitts.

Hung discloses an energy transducer comprising an omni-directional electro-mechanical transducer (A) coupled to a mounting base (T), wherein the electro-mechanical transducer includes an anemometer, with rotatable elements (D).

Hill discloses an energy transducer comprising an omni-directional electro-mechanical transducer (11) coupled to a mounting base (17), wherein the electro-mechanical transducer includes an anemometer, with rotatable elements (10).

Pitts discloses an energy transducer comprising an omni-directional electro-mechanical transducer (A) coupled to a mounting base (52), wherein the electro-mechanical transducer includes an anemometer, with rotatable elements (60).


Claims 1, 14 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Thershein. Thershein discloses an energy transducer comprising an electro-mechanical transducer (29) coupled to a mounting base (12).

Claims 1, 10, 14 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Carroll. Carroll discloses an energy transducer comprising an omni-directional electro-mechanical transducer (e.g. 40) coupled to a mounting base (e.g. anchor, fig 2).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is 571- 272-4821. The examiner can normally be reached on Monday-Thursday from 6:15 AM -3:45 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on 571-272-4820. The official fax number is 571-273-8300. Any inquiry of a general nature should be directed to the Help Desk, whose telephone number is 1-800-PTO-9199.

  
F. Daniel Lopez  
Primary Examiner  
Art Unit 3745  
January 19, 2007